

Kishore C. Acharya

S/N: 09/682,430

REMARKS

Claims 1-36 are pending in the present application. In the Office Action mailed April 27, 2005, claims 1-36 stand rejected under 35 U.S.C. §102(e) as being anticipated by Jaszcak et al. (USP 6,629,469). Applicant's response to Office Action dated September 27, 2004 was deemed non-responsive by the Examiner. In the response, Applicant requested that the Examiner include a copy of the provisional application U.S. Ser. No. 60/209,520 in a non-final Office Action such that a review of the provisional application could be made to determine whether the subject matter of 6,629,469 upon which the Examiner has relied to support the rejection of claims 1-36 was, in fact, in entitled to the benefit of the filing date of the provisional application. The Examiner did not provide a copy of the provisional application and in doing so stated "that the burden to overcome Jaszcak et al." is on the Applicant.

Applicant agrees that the burden to overcome a reference relied upon by the Examiner is on the Applicant; however, the burden is on the Examiner to establish that the reference relied upon for a rejection under 35 U.S.C. §102(e) qualifies as a reference thereunder. See MPEP §706.02(f)(1). It is well established that "the 35 U.S.C. 102(e) critical reference date of a U.S. patent ... entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph." MPEP §2136.03(III), (emphasis added). As such, the Examiner can rely upon the filing date of a provisional application from which a U.S. patent claims priority as the effective reference date for the U.S. patent only if the provisional application contains "written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention." 35 U.S.C. §112, first paragraph. By not providing a copy of the provisional application as requested by the Applicant, the Examiner has failed to establish that June 5, 2000 is the effective reference date of USP 6,629,469. As such, the Examiner has failed to establish that the disclosure of USP 6,629,469 is entitled to the benefit of the filing date of June 5, 2000. As the Examiner has had two opportunities to establish that the disclosure of USP 6,629,469 is supported by U.S. Ser. No. 60/209,520, Applicant can only conclude that the provisional application fails to enable the disclosure of USP 6,629,469 that Examiner is relying upon to reject claims 1-36.

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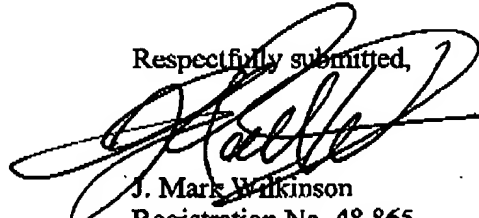
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Accordingly, Applicant refers the Examiner to the Declaration Under 37 CFR §1.131 enclosed herewith disqualifying the disclosure relied on by the Examiner to reject claims 1-36. As set forth in the Declaration, the subject matter of the present application was conceived prior to June 5, 2001, the filing date of Jaszcak et al., and Applicant was diligent in working with counsel in preparing and filing the present application. Accordingly, Applicant believes that Jaszcak et al. is disqualified as prior art against the claimed invention and any rejection based thereon must be withdrawn.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-36.

Applicant appreciates the Examiner's consideration of these Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



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